

REMARKS

This application has been amended in a manner believed to place it in condition for allowance at the time of the next Official Action.

Claims 1 and 3-9 are pending in the application. Claims 1 and 3-9 have been amended to address formal matters. Independent claim 1 has been amended to incorporate the recitations of claim 2. Claim 2 has been canceled.

Claims 1 and 3-9 were rejected under 35 USC §103(a) as allegedly being unpatentable over FUJIMOTO in view of NAKAMURA et al. and TASHIRO et al. This rejection is respectfully traversed.

FUJIMOTO discloses a color electrophotographic image receiving material comprising a substrate and a toner image receiving layer. The substrate consists of a base paper and a resin layer (column 2, lines 50-60).

FUJIMOTO states that the base paper used for the color electrophotographic image receiving material may be any paper that can tolerate the fixing temperatures yet still provide acceptable levels of smoothness, whiteness, slipping and frictional properties, anti-static properties, and surface deformation properties after fixing (column 2, lines 60-65). The resin layer may be a polyolefin resin (column 3, line 58). FUJIMOTO discloses that the resin layer plays an essential role in suppressing the change of moisture content in the base paper (column 3, lines 39-40).

In imposing the rejection, the Official Action acknowledges that FUJIMOTO fails to disclose a base paper as recited in the claimed invention. In an effort to remedy the deficiencies of FUJIMOTO for reference purposes, the Official Action cites to NAKAMURA.

NAKAMURA discloses an image-receiving sheet for electrophotography comprises a base paper. It appears that the Official Action on page 3 cites to paragraphs 16 and 18 for the proposition that NAKAMURA discloses a base paper with at least one of an alkali metal salt and an alkaline earth metal salt. The Official Action cites to paragraph 187 of NAKAMURA as disclosing that these amounts may be in an amount of  $0.8 \text{ g/m}^2$ .

However, the passages identified by the Official Action relates to sizing agents and fixing agents. NAKAMURA does not necessarily disclose that at least one of an alkali metal salt and an alkaline earth metal salt should be present in the base paper. Furthermore, NAKAMURA does not teach that the salts may be present in an amount of  $0.6$  to  $3 \text{ g/m}^2$ . In this regard, it is believed that NAKAMURA cannot remedy the deficiencies of FUJIMOTO for reference purposes.

In an effort to remedy the deficiencies of FUJIMOTO and NAKAMURA for reference purposes, the Official Action cites to TASHIRO et al. for the proposition that it would have been obvious to provide a base paper with a moisture content more than 6.5% by weight or more of the base paper.

TASHIRO et al. disclose a paper having an absolute dry moisture content of 1.8 to 7% (abstract). The paper may be used as a photographic support (column 1, lines 10-15). However, there is no recognition of a base paper having the claimed moisture content from 6.5% to 8.5% by weight of the base paper. Furthermore, TASHIRO is silent as to whether at least one of an alkali metal salt and an alkaline earth metal salt may be present in the paper.

Accordingly, TASHIRO cannot remedy the deficiencies of FUJIMOTO and NAKAMURA for reference purposes so as to suggest to one skilled in the art to provide a base paper with a salt arranged of from 0.6 to 3 g/m<sup>2</sup>.

Indeed, applicants note that the claimed invention exhibits unexpected results when the claimed amounts of salt and moisture content are provided in the base paper. The Examiner's attention is respectfully directed to Tables 1 and 2 in the present specification beginning on page 75. Examples WE 5 and WE 6 are directed to base papers that fall outside the claimed range for the recited salts. Comparative Examples CE2 and CE3 fall outside the recited ranges for the claimed moisture content and amounts of salts present in the base paper. Upon viewing Table 2, it is apparent that while Examples WE 5 and WE 6 exhibit an excellent feeding property, they do not necessarily provide the same image quality as the other examples. While the Comparative Examples CE1, CE2, and CE3 may each provide an acceptable image

quality, the feeding properties of the comparative examples exhibit inferior feeding properties.

In view of the above, applicants respectfully submit that the claimed amounts of salt and moisture content provide an electrophotographic image receiving sheet that provides an unexpected and satisfactory image quality along with a stable feeding property free from an occurrence of jamming and double feed.

In this regard, the Examiner must consider objective indicia of non-obviousness whenever present. Specifically, the Examiner is bound to consider evidence of unexpected results, commercial success, long-felt but unresolved needs, failure of others, skepticism of experts. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983). In particular, Federal Circuit precedent mandates consideration of comparative data in the specification which is intended to illustrate the claimed invention in reaching a conclusion with regard to the obviousness of the claims. *In re Margolis*, 785 F.2d 1029 (Fed. Cir. 1986) (Vacating a board decision which refused to consider data in the specification which compared an embodiment of the invention with the prior art product and noting that such evidence spoke to unexpected results in non-obviousness). Furthermore, evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with

the closest prior art which is commensurate in scope with the claims. MPEP §716.02(e)(III).


Thus, applicants respectfully submit that the proposed combination of FUJIMOTO, NAKAMURA, and TASHIRO fails to render obvious claims 1 and 3-9.

In view of the present amendment and foregoing remarks, therefore, applicants believe that the present application is in condition for allowance at the time of the next Official Action. Allowance and passage to issue on that basis is respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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